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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,458	01/30/2002	Fumiaki Arai	58122-Z CCD	6616

7590

06/07/2006

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

Office Action Summary	Application No. 10/060,458	Applicant(s) ARAI ET AL.	
	Examiner Frederick J. Parker	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11-15,21 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 05-262057 (JP057).

JP057 teaches forming a thermal sensitive porous sheet comprising a plastic film base [0011] on which is applied a porous resin imaging layer. The layer is formed using a water/oil emulsion, a thermoplastic polyurethane resin added drop wise and distributed into the oil phase, within the water phase is inherently discontinuously distributed in the oil by virtue of their inherent surface tension properties [0013-14]. The applied coating is dried to form the porous coating. The formulation also includes an emulsifier to form an emulsion and an organic solvent [0012,0014].

As to the amended version of claim 11, the Examiner notes only the preamble cites the limitation that the film be “perforable by use of a thermal head” (emphasis added). Thus, the limitation is merely directed to use with no intentional purpose, and further the limitation fails to give “life, meaning, and vitality” to the claim steps, MPEP 2111.02, first three sections. The process of the prior art anticipates that of the claim as written, and therefore is inherently capable of being “perforable by use of a thermal head”. The Examiner also points out a thermal head is utilized in the prior art reference, see for example [0023,0028].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP057 in view of GB 2306689 (GB689).

JP057 is cited for the same reasons previously discussed, which are incorporated herein.

Alternate resin film formers and layer properties are not cited.

GB689 forms a porous thermal sensitive stencil sheet comprising a porous resin layer on a thermoplastic film using the process described on page 8, 23 to page 9, 30, which is similar to the concept of the multi-phase coating system of JP057. GB689 teaches resin layer materials including polyvinyl butyral resin (p.6, 31) per claim 16, and it therefore would have been obvious to substitute the film forming resin of GB689 for that of JP057 because the resins are disclosed to be suitable for the same purpose. The reference provides specific criteria for coated porous sheets including a flexural rigidity of 5-200N to allow proper transfer in a printer;

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porosity of 1-157 cc/cm²-sec; average pore size diameters of 2-50 microns and a total porosity of 4-80%, which meet or overlap the ranges of Applicants claims 17,18,20. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made if the overlapping portion of the ranges disclosed by the reference were selected because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Wortheim* 191 USPQ 90. Fillers are cited on p.7, 10 per claim 19 to control strength, stiffness, and pore sizes of the resin coatings.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of JP057 by incorporating the fillers and substituting alternate film resins, and to optimize the film properties to meet the criteria set forth by GB689 to provide thermally sensitive porous stencil sheets with optimal/ useful porosity/pore size and mechanical properties.

Response to Arguments

Applicants amendments and clear, concise arguments have been fully considered. Applicants have amended the preamble of independent claim 11 to recite the limitation that the film be “perforable by use of a thermal head”. Thus, the limitation is merely directed to use with no intentional purpose, and further the limitation fails to give “life, meaning, and vitality” to the steps of claim 11+, per MPEP 2111.02, first three sections. Since no positive step of perforating is required by claim 11, the prior art product would have been able/ capable of being perforated by a thermal head since the process steps of the prior art anticipates the process of at least claim 11 as written. The Examiner also points out a thermal head is utilized in the prior art reference,

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see for example [0023,0028]. Consequently, the rejection of dependant claims 12-21 are equally valid and are maintained.

Argument on page 6 that the film base material be “perforated by ... use of a thermal head” is not commensurate with scope of claims because the claims never recite a positive step of doing so.

The differences alluded to on page 6 are not convincing because the method as claimed is the same as the prior art, and hence would have been expected to provide the same outcomes.

Similarly, the argument that the properties of the process of the present invention and that of the prior art are not necessarily inherently the same is not persuasive because two processes which are the same would produce the same outcome. If Applicants product is unlike that of the prior art, then critical steps to reach that end must be missing. The Examiner also notes that Applicants’ advantage of the film making process- high coating speed and improve productivity- are basically the same advantages noted by JP’073, [0003} and elsewhere.

The secondary references are cited for the same reasons previously disclosed and as discussed again above. They simply introduce alternate resin film formers and properties which would have been expected to have been combinable with JP’057 to attain the benefits expressly set forth.

Applicants amendments and arguments are not persuasive, and the rejection of claims 11-21 are maintained.

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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

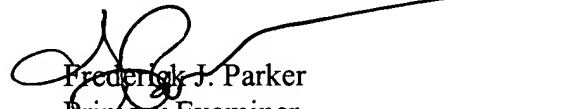
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp